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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,821
Filing Date: November 24, 2003
Appellant(s): WILSON, DOUGLAS B.

Wayne M. Kennard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 18, 2010 appealing from the Office action mailed May 13, 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: the appeal in copending parent Application No. 10/727,306 filed on June 18, 2010.

(3) Status of claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 20-28 and 39.

Claim 39 has been substituted for the finally rejected claim 29.

(4) Status of Amendments after Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of claimed subject matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

A. Claims 20-28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (JP 4-78769).

B. Claims 20-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 14-17, 24, and 27 of copending Application No. 10727306 (hereinafter “Appl.’306”).

C. Claims 27 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 19/18 of copending Appl.’306.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

JP 4-78769

Shigeru

March 12, 1992

(9) Grounds of rejection

The following grounds of rejection are applicable to the appealed claims:

A. Claims 20-28 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (JP 4-78769).

Claim 20

Shigeru teaches a fatigue relieving/preventing apparatus associated with a steering wheel 2 for controlling a vehicle comprising:

a first section (at a’ in FIG. 2, see Appendix hereinafter “App.”) that connects to *an upper one-half* of a peripheral portion of the steering wheel (FIG. 1);

a second section (at 1 in FIG. 1 or 2, see App.) extends from the first section at the peripheral portion of the steering wheel 2, the second section extends from the first section outward at an angle (α in App., FIG. 4) to a plane across a face to the steering wheel 3 (FIG. 4 or 5), the second section is capable of providing resting support for at least a portion (*e.g.*, the hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2. Shigeru, pp. 1 and 4 of translation.

Claim 21

The second section is deformable in at least one direction when deforming pressure is applied to such second section since it is made of a flexible cushion material 9 (FIG. 3). Shigeru, pp. 3 and 4 of translation.

Claim 22

The second section provides resting support for a portion of the vehicular operator's body when resting support pressure from such body portion is applied in at least one direction. Shigeru, pp. 1 and 4 of translation.

Claim 23

The steering wheel 2 includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

Claim 24

The second section will return to an original first position after deforming pressure is removed therefrom since it is made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, p. 3 of translation.

Claim 25

The portion of the body supported by the second section includes at least a forearm, wrist, or hand. Shigeru, p. 3 of translation.

Claim 26

The first section (at a' in FIG. 2) extends a length of a predetermined peripheral portion of the steering wheel 2 (FIG. 1).

Claim 27

Shigeru teaches at least a first first section (on the left of the steering wheel 2 shown in FIG. 1, see App.) and a second first section (on the right of the steering wheel 2 shown in FIG. 1, see App.) that connect to an upper one-half of a peripheral portion of the steering wheel 2, and at least a first second section (at 1 on the left of the steering wheel 2 shown in FIG. 1, see App.) and a second second section (at 1 on the right of the steering wheel 2 shown in FIG. 1, see App.) that connect to, and extends from the first and second first sections (FIG. 1), respectively, with the first and second second sections extending from the respective first and second first sections outward at an angle (α in App., FIG. 4) to a plane across a face to the steering wheel 2, the first and second second sections, each providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section is less than the pressure for deforming the first or second second

section out of interference with the vehicular operator's ability to operate the steering wheel 2, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the first or second second section is equal to or greater than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel 2.

Claim 28

The first and second first sections are deformable since they are made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, pp. 3 and 4 of translation.

Claim 39

The first section (at a' in FIG. 2) is deformable since it is made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, pp. 3 and 4 of translation.

B. Claims 20-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 14-17, 24, and 27 of copending Appl.'306.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-26 of this application and claims 14-17, 24, and 27 of Appl.'306 claim common structures such as a first section and a second section connected to the first section. To the extent that claims 14-17, 24, and 27 in Appl.'306 call for the second section being *rigid*, *semi-rigid*, *flexible*, or deformable, meanwhile, claims 20-26 in this application call for the second section being deformable, however, the terms "rigid," "semi-rigid," "flexible," and "deformable" are relative terms. See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969) ("Flexibility" and "rigidity" are relative terms, particularly since virtually anything will

flex if enough pressure is applied to it.). On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP § 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in claims 20-26 of this application such that it is rigid, semi-rigid, or flexible as claimed in claims 14-17, 24, and 27 of Appl.'306 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin*, *supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

C. Claims 27 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 19/18 of copending Appl.'306.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 27 and 28 of this application and claims 18 and 19/18 of Appl.'306 claim common structures such as at least two second sections (*i.e.*, a first second section and a second second section) that each connected to the first section at separate location. To the extent that claims 18 and 19/18 in Appl.'306 call for the second section being rigid, semi-rigid, flexible, or deformable, meanwhile, claims 27 and 28 in this application call for the second section being deformable, however, the terms "rigid," "semi-rigid," "flexible," and "deformable" are relative terms. In fact, when the second section is rigid, semi-rigid or flexible, it is inherently deformable if enough pressure is applied to it. *Fredman v. Harris-Hub Co., Inc.*, *supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the at least two second sections claimed in claims 27 and 28 of this application such that they are rigid, semi-rigid, or flexible as claimed in claims 18 and 19/18 of Appl.'306 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to argument

I. PRINCIPLE OF LAW

As noted from pages 11 and 12 of the Board decision on September 2, 2009:

"A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002)." See also *Verizon Services Corp. v. Cox Fibernet Virginia Inc.*, 94 USPQ2d 1833 (Fed. Cir. 2010).

"A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

... where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

II. ANALYSIS

A. Claims 20-28 and 39 are anticipated by Shigeru

At the outset, Appellant contended that Shigeru's support 1 is constructed of *rigid*, lightweight molded plastic (Brief p. 11).

The Examiner respectfully submits that Appellant's contention is unsupported by substantial evidence in the record. In fact, on the one hand, the term "*rigid*" is not appeared in the translation of Shigeru reference. On the other hand, contrary to Appellant's subjective conjecture, Shigeru expressly teaches:

"In the internal structure of support 1, molded part 8 is a *light-weight plastic* and relieves fatigue of a portion of the hands in contact with the *cushion material* thereon by covering the hand. A surface material 10 can be made with a cloth or with leather." (Translation p. 3) (Emphasis added)

"almost all parts are formed into curved surfaces and are covered all over with *flexible cushion 9* when they are fixed to steering wheel 2." (Translation pp. 3 and 4) (Emphasis added)

Thus, Shigeru reference as a whole discloses that the support 1 is flexible cushion, *i.e.*, it is not *rigid*, lightweight molded plastic as evidenced from the quotation above. See MPEP § 2143.03. Moreover, Shigeru's device uses the cushion material to support a body part to relieve fatigue of the driver's hand in the same manner as Applicant's device. As noted, the cushion is

soft as defined by common standard dictionary. *Cf.*, unpublished *In re Opprecht*, 12 USPQ2d 1235 (Fed. Cir. 1989) (anticipation prior art needs not provide such explanation to anticipate when an artisan would know as evidenced by standard textbook). This fact is clearly evidenced by numerous references related to body supports, such as, *e.g.*, pillows, classified in Class 5 (beds) of the Office.

On the other hand, assuming *arguendo* that Shigeru's support 1 is rigid, lightweight molded plastic as alleged, the Examiner respectfully submits that Shigeru's support 1 still "reads on" the claimed element "*a second section*" in claim 20. Put differently, Appellant's tandem arguments relied on the alleged "*rigid*, molded plastic" are unavailing due to the fact that Appellant's appealed claim 20 does not preclude the *rigid*, lightweight molded plastic material.

Second, Appellant asserted that Shigeru reference teaches away from the present invention. (Brief p. 13)

As noted from MPEP § 2131.05, it is well settled that:

Arguments that the alleged anticipatory prior art is 'nonanalogous art' or '*teaches away* from the invention' or is not recognized as solving the problem solved by the claimed invention, [*are*] not '*germane*' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)).

The question whether a reference "*teaches away*" from the invention is *inapplicable to an anticipation analysis*. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). >See *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included

that same ingredient);< see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of “sufficient aeration” even though reference taught away from air entrapment or purposeful aeration.). (Emphasis added)

Third, Appellant asserted that Shigeru does not teach or suggest the present invention for the same reasons the Board found in the Board decision on September 2, 2009 that the present invention was not anticipated by US 2,118,540 (Van Arsdell) or US 1,575,828 (Laubach). (Brief pp. 14-17)

The Examiner respectfully submits that Appellant apparently overlooked the reasons the Board found that the present invention was anticipated by US 2,134,020 (Anson) on pages 14 and 15 of the above decision.

In the instant case, similarly to Anson, the Board should find that Examiner has clearly found that Shigeru prefers to use a *flexible* cushioning composition/material to form the grip portion 1 that the Examiner is utilizing to read on the second structural aspect as seen in the rejection. An article of manufacture made from a cushioning *flexible* composition would inherently have a capability to deform out of interference. The amount of deformation out of interference would be dependent upon the resilience property of the cured light-weight plastic and not its form. Appellant tries to show that Shigeru does not inherently possess the characteristic of deforming out of interference because the grip would either not be used in operation (*i.e.*, the grip would not be locked or fixed in place and not movable from that place until the locking or fixing tension was removed) (Brief p. 17), or would not achieve the recited benefits (*i.e.*, deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to

operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel) (Brief p. 18). Neither argument outweighs the explicit disclosure that Shigeru's device is manufactured from a material that is *flexible* and thus would have an inherent property of being deformable.

In summary, in this case, the Examiner has good reason to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, is, in fact, an inherent characteristic of Shigeru's steering attachment. In such a case, the Appellant must provide evidence that Shigeru's steering attachment is not capable of deforming out of interference. See *Swinehart*, 439 F.2d at 213. Arguments that focus on a particular envisioned use of a device in a particular driving condition is not evidence that the device is not inherently capable of deforming out of interference. As such, Appellant has not met his burden of showing that Shigeru's steering attachment is not capable of deforming out of interference as set forth in claim 20. Hence, claims 21-28 and 39 fall with claim 20.

B. Obviousness-Type Double Patenting Rejection is Proper

Appellant contended that the judicially created rejection of obviousness-type double patenting rejection should be reversed because Appellant has filed a Terminal Disclaimer in the copending Appl.'306. (Brief pp. 18-21)

The Examiner respectfully submits that MPEP § 804.02 states:

*A terminal disclaimer filed to obviate a double patenting rejection is effective **only** with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. If an appropriate > "provisional" nonstatutory< double patenting rejection ** is made in >each of< two or more pending applications, **>the examiner should follow the practice*

set forth in MPEP § 804, subsection I.B.1. in determining in which of the applications an appropriate terminal disclaimer must be filed. (Emphasis added)

In addition, MPEP § 804, subsection I.B.1. states:

1. Nonstatutory Double Patenting Rejections

*If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is **the only rejection** remaining in the earlier filed of the two pending applications, while the later filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.*

*If “provisional” ODP rejections in two applications are **the only rejections** remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. (Emphasis added)*

In the instant case, Appl.’306 is the later-filed application and this Appl.’821 is the earlier filed of the two applications. However, *the obviousness-type double patenting rejection is not **the only rejection*** remaining in this earlier filed of the two pending applications, meanwhile, the later filed Appl.’306 is also rejectable on other grounds. Hence, the Examiner respectfully submits that the obviousness-type double patenting rejection in this application should be

affirmed because the terminal disclaimer filed to obviate the double patenting rejection in Appl.'306 is effective only with respect to Appl.'306 per MPEP *supra*.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Vinh T Luong/
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Appeal conference on July 12, 2010:

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